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Attorney Docket: 009523-0283651

### REMARKS

Claims 1-18 and 20-38 are pending. Claims 1-4, 7-20 and 27-37 are withdrawn as being drawn to non-elected species, the requirement having been traversed. By this Amendment claims 19 and 39 are canceled without prejudice or disclaimer and claims 5, 6, 16 and 17 are amended. Reconsideration in view of the above amendments and following remarks is respectfully requested.

With respect to the election of species requirement, MPEP § 904 states: "The examiner, after having obtained a thorough understanding of the invention disclosed and claimed in the nonprovisional application, then searches the prior art as disclosed in patents and other published documents, i.e., nonpatent literature (NPL)." MPEP § 904.02 states: "The search should cover the claimed subject matter and should also cover the disclosed features which might reasonably be expected to be claimed." It is respectfully noted that the Examiner has already searched and examined the application. Accordingly, it is not understood what serious burden exists. See also MPEP § 811.

With respect to the Examiner's allegation that "Applicant's determination that the claims have been used to define the species in the given election is incorrect," it is respectfully submitted that it is the Examiner who is incorrect. The March 8, 2005 Office Action clearly set forth the species as defined by the claims, and not by the specifically different embodiments. It is also respectfully noted that the Examiner's indication of the various species is incorrect. For example, the Examiner states that Species II is claims 5, 21-26, 38 and 39, "directed to a variable optical characteristic optical element utilizing an electrostatic force or piezoelectric force." None of claims 5, 21-26, 38 and 39 recite an electrostatic force or a piezoelectric force. In fact, claim 6 recites these features and clearly establishes differentiation with claim 5. The Examiner's attempt to limit claims 5, 21-26, 38 and 39 by paraphrasing or summarizing what the Examiner considers to be the subject matter defined by the claims is clearly improper, unwarranted and unappreciated. 35 U.S.C. § 112, 2<sup>nd</sup> paragraph requires that the claims particularly point out and distinctly claim the subject matter Applicants regard as their invention, not what the Examiner regards as the invention. Applicants have done so. And Applicants don't regard any of the inventions defined by claims 5, 21-26, 38 and 39 to be limited to utilizing an electrostatic force or piezoelectric effect.

Applicants also respectfully note that in the December 18, 2003 and March 13, 2004 Office Actions, claim 15 was rejected only under 35 U.S.C. § 102(f). As Applicants' August

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11, 2004 response clearly overcame the rejection of claim 15 under this grounds, it is respectfully submitted that claim 15 is allowable and should be indicated as such, not withdrawn from further consideration. The Examiner has considered claim 15 and Applicants have responded. The only further consideration of claim 15 necessary is a timely notice of its allowability.

Similarly, the only grounds of rejection presented against claim 19 in the December 18, 2003 and April 13, 2004 Office Actions was under 35 U.S.C. § 102(f). As Applicants have overcome this rejection, and have amended claims 16 and 17 to include the features of claim 19, it is respectfully submitted that claim 16, and dependent claims 18 and 20, and claim 17 are allowable. Prompt notice to that effect is respectfully requested.

With respect to the Examiner's allegation that Applicants were "invited to provide their own listing of claims" for the elected species, as discussed above and in the previous response, as the Examiner defined the species by the claims, and not by the specifically different embodiments, Applicants could not have accepted the invitation.

With respect to the Examiner's determinations that "[e]ach of the described/defined species of the present application contain mutually exclusively details," MPEP § 806.04(f) states: "The general test as to when claims are restricted, respectively, to different species is the fact that one claim recites limitations which under the disclosure are found in a first species but not in a second, while a second claim recites limitations disclosed only for the second species and not the first." (Underlining emphasis added.) Claim 1, which the Examiner identifies as belonging to Species I, recites that the variable-optical-characteristic optical element is characterized by using at least two selected from the group consisting of electrostatic force, electromagnetic force, a piezoelectric effect, magnetorestriction, a fluid pressure, a magnetic field, an electromagnetic wave, a temperature change, and a photomechanical effect. Claim 7, which the Examiner identifies as belonging to Species III, recites, *inter alia*, a variable-optical-characteristic optical element comprising a deformable optical surface and a member for creating a magnetic field. Accordingly, the limitation of a magnetic field is found in Species I and Species III. In other words, the limitation of the magnetic field is clearly not mutually exclusive to any one species. Numerous other limitations are recited in the pending claims which are clearly not mutually exclusive to any one species. For example, the limitation of a photomechanical effect is recited in both claim 1 (Species I) and claim 12 (Species V) and is clearly not mutually exclusive.

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Reconsideration and withdrawal of the election of species requirement are respectfully requested.

Claims 5 and 6 were objected to. It is respectfully noted that no basis in either 35 U.S.C. or 37 C.F.R. was given for the objection. As such, it is respectfully submitted that the objection is improper. However, in order to advance prosecution of the application, claims 5 and 6 have been amended to obviate the objection.

Claim 39 was objected to under 37 C.F.R. § 1.75(c). Claim 39 has been canceled without prejudice or disclaimer, thus rendering moot its objection.

Claims 5 and 6 were rejected under Hochstrate (U.S. Patent 4,238,793). The rejection is respectfully traversed.

Claim 5 recites a variable-optical-characteristic optical element comprising a power source and a driving circuit for driving said variable-optical-characteristic optical element. The power source or driving circuit includes a booster member that generates a voltage necessary in said driving circuit. The variable-optical-characteristic optical element is capable of achieving optical deflection.

Hochstrate discloses an electroluminescent (EL) panel 10 including a plurality of multiplexed segmented electrodes 3A-3F. An electric field is sequentially applied across each segmented electrode and a common electrode 5 at a predetermined repetition rate greater than a decay rate of the electroluminescent material so that the panel is continuously illuminated and functions as unitary backlight source for a display. In Figure 6 and the accompanying text, the common electrode 5 is impulsed by a piezoelectric transponder/transformer.

There is no disclosure or suggestion by Hochstrate that the segmented electrodes are capable of achieving optical deflection. Therefore, Hochstrate cannot anticipate or render obvious claim 5.

Claim 6 recites additional features of the invention and is allowable for the same reasons discussed above with respect to claim 5 and for the additional features recited therein.

Reconsideration and withdrawal of the rejection of claims 5 and 6 over Hochstrate et al. are respectfully requested.

Claims 21-26, 38 and 39 were rejected under 35 U.S.C. § 102(b) over Schachar (U.S. Patent 5,774,274). The rejection is respectfully traversed.

Claim 21 recites a variable-optical-characteristic optical element having a deformable optical surface, which further comprises a control system for driving the variable-optical-

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characteristic optical element. The control system includes a booster member for creating a voltage necessary for driving the variable-optical-characteristic optical element.

The Examiner alleges that the embodiment of Figure 9 of Schachar, including the solenoid 406, corresponds to the booster member of claim 21. The solenoids 406 are fastened to a deformable lens 402 by clamps 408. When the solenoids 406 are actuated, the equatorial diameter of the lens 402 is increased. It is respectfully submitted that the solenoids 406 of Schachar are devices that include an iron core driven by an electromagnetic force, i.e. they are conventional solenoids in which a plunger is actuated (i.e. moved) by an electromagnetic force. The solenoids 406 of Schachar deform the lens 402 by movement of their plungers, which are clamped to the lens 402. The solenoids 406 of Schachar do not create a voltage for driving the deformable lens 402 and do not correspond to the booster member of claim 21.


Claims 22-26 recite additional features of the invention and are allowable for the same reasons discussed above with respect to claim 21 and for the additional features recited therein.

Reconsideration and withdrawal of the rejection of claims 21-26, 38 and 39 over Schachar are respectfully requested.

In view of the above amendments and remarks, Applicants submit that all the claims are allowable and that the entire application is in condition for allowance.

Should the Examiner believe that anything further is desirable to place the application in better condition for allowance, the Examiner is invited to contact the undersigned at the telephone number listed below.

Respectfully submitted,  
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